

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB FEB. 7,00

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Daniel L. Kegan dba Elan Associates  
v.  
Marc S. Lane

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Opposition No. 102,966  
to application Serial No. 74/678,682  
filed on May 22, 1995

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Request for Reconsideration

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Daniel L. Kegan of Kegan & Kegan, Ltd. for Daniel L. Kegan  
dba Elan Associates.

Marc S. Lane, pro se.

Before Simms, Cissel and Bottorff, Administrative Trademark  
Judges.

Opinion by Simms, Administrative Trademark Judge:

Opposer seeks reconsideration of our October 27, 1999  
decision wherein the Board held that applicant's mark  
LINEGUIDE for certain computer services was not likely to  
cause confusion with opposer's marks MACGUIDE, PCGUIDE,

HYPERGUIDE, OPENGUIDE, POWERGUIDE, WINGUIDE, NEXGUIDE and WEBGUIDE.

Opposer states that, "[b]ased on applicant's report of an 800-item trademark application database search, the Board concluded that the relevant public may be confronted with various other third-party marks terminating in the suffix -GUIDE." In this regard opposer states (correctly) that third-party applications and registrations do not evidence use by the owners of such marks or awareness of those marks by the relevant public, nor do they demonstrate what happens in the marketplace. Opposer states that the only evidence to support the Board's conclusion was applicant's trademark search report.<sup>1</sup>

Opposer is incorrect in asserting that the only evidence of third-party use is from applicant's trademark search report, which, of course, does not demonstrate use of those marks. Aside from the various third-party marks which opposer has litigated in federal court (including use by Apple Computer Inc. of the marks APPLE GUIDE and MACINTOSH

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<sup>1</sup> Opposer also states that these third-party registrations were not properly made of record because applicant did not file a notice of reliance thereon. Opposer's Request for Reconsideration, 5-6. Opposer is incorrect that third-party registrations may only be introduced by filing a notice of reliance thereon. There are other means for introducing third-party registrations. See TBMP §703.02(b) and cases cited therein.

GUIDE for software,<sup>2</sup> and Super Guide Corporation's SUPERGUIDE mark for computer programs and various television accessories), opposer's testimony also makes note of another entity (CMP Media) that has attempted to develop a family of -GUIDE marks (NetGuide, TechGuide, CyberGuide, GameGuide, and others). See Kegan dep., 364, and opposer's brief, 8. Moreover, both in the civil litigation and in this proceeding, opposer has stated that he makes no claim to the exclusive use of the word "GUIDE" per se for computer programs and does not have exclusive rights to use "GUIDE" as a suffix in trademarks. See, for example, Kegan dep., 274.

Opposer also takes issue with the Board's decision insofar as it has given weight to the conclusions of the District Court for the Northern District of Illinois in *Kegan v. Apple Computer Inc.*, 42 USPQ2d 1053 (1996). Opposer has pointed to the elements necessary before a court (or the Board) may apply the doctrine of collateral estoppel, and argues that it was not necessary for the Court to find that "GUIDE" was generic, and that this holding was dictum because it was not needed in order to determine the

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<sup>2</sup> See also opposer's response to applicant's Interrogatory No. 45, wherein opposer refers to "Apple's family of Guide trademarks."

lack of likelihood of confusion.<sup>3</sup> As we pointed out in the decision complained of, the issue concerning the genericness of a component of opposer's asserted family of marks in the civil case was identical to an issue before us. If a term is descriptive and lacks secondary meaning or acquired distinctiveness or if a term is generic, then that term cannot form the basis of an asserted family of marks.

*Marion Laboratories Inc. v. Biochemical/Diagnostics Inc.*, 6 USPQ2d 1215, 1219 (TTAB 1988) and McCarthy on Trademarks and Unfair Competition, Sections 12:1 and 22:61 (4<sup>th</sup> ed. 1999).

While, of course, the specific issues of likelihood of confusion in the civil case and in this case were different because they involved different marks, the Court's determination, at 1060, that "GUIDE" is generic for magazines and that any likelihood of confusion must be based on the similarity of the prefixes (and, therefore, of the marks as a whole, individually) rather than on a family of - GUIDE marks, is entitled to preclusive effect.

Accordingly, opposer's request for reconsideration is denied.

R. L. Simms

R. F. Cissel

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<sup>3</sup> Opposer also states (incorrectly) that Apple never claimed in the civil litigation that APPLE GUIDE was its trademark or service mark. See Request for Reconsideration, 11.

Opp. No. 102,966

C. M. Bottorff  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board